



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/246,409	02/08/1999	SHMUEL SHAFFER	99-P-7454-US	6137

7590 06/19/2003
SIEMENS CORPORATION
186 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

CHOW, MING

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 06/19/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/246,409

Applicant(s)

SHAFFER ET AL.

Examiner

Ming Chow

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 2 and 10 recite the limitation "said message" on line 3 in claim 2. It is unclear the claimed "said message" refers to "a message" on line 2 of claim 2 or "a message" on line 3 of claim 2. It is obvious the "a message" on line 2 and "a message" on line 3 are two different messages. The "a message" on line 2 refers to, for example, message 402a of Fig. 4 in the specifications. The "a message" on line 3 refers to, for example, message 400 of Fig. 4 in the specifications.
2. Claims 3 and 11 recite the limitation "said message" on line 4 in claim 3. It is unclear the claimed "said message" refers to "a message" on line 2 of claim 3 or "other messages" on line 2-3 of claim 3.
3. Claims 4-7 and 12-15 recite the limitation "said message". It is unclear the claimed "said message" refers to "a message having other messages threaded within", "other (threaded) messages", or both.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Kennedy (US: 6330589). Kennedy teaches on item 38 Fig. 3 “local message store” (claimed “memory”). Kennedy teaches on Fig. 4a and 4b messages are threaded with other one or more messages. Kennedy also teaches on column 3 line 47-50 the reply message (claimed “threaded message”; see line 4-5 page 8 of the specifications for definition of “thread messages” by Applicant) includes a message identifier for a root message (claimed “includes at least a portion of another message”). Kennedy further teaches on column 3 line 53-58 and Fig. 5 the root message (claimed “another message”) and reply message are grouped (to be a threaded message). Kennedy also teaches on item 36 Fig. 3 email program module (claimed “controller”; including item 37 Fig 3 message manager program module).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy as stated in claim 1 above, and in view of Luzeski et al (US: 6430177). Kennedy teaches on Fig. 4c “message 2” (claimed “a message threaded within another Kennedy failed to teach “controller being.....has been accessed”. However, “Official Notice” is taken that a message (including the original message and its threaded reply message) is indicated as has been accessed is old and well known to one skilled in the art. When the message is indicated “accessed” any message included in is inherently indicated “accessed”.

6. Claims 3-7, 11-15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy as stated in claim 2 above, and in view of John Alson Hicks, III (US-PAT-NO: 6,304,573 B1).

Regarding claim 3-7, 11-15, 17, 19, Kennedy failed to teach the deleting and saving actions by the controller to the email and voice mail messages. However, Hicks teaches on Column 3 Line 49 the actions of deleting and saving on the email and voice mail messages (Column 3 Line 62). It would have been obvious to one skilled at the time the invention was

Art Unit: 2645

made to modify Kennedy for including the deleting/saving actions to the email and voice mail messages such that the modified system of Kennedy would be able to support these well known deleting/saving features to the system users.

Regarding claims 18 and 20, Kennedy teach on column 8 line 4-11 the system provides phone support. Kennedy also teach on column 7 line 52-54 the connections include a LAN. Therefore, Kennedy's system comprises a telephony-over-LAN messaging system.

7. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy as stated in claim 1 above, and in view of Lytle et al (US: 6549950). Kennedy failed to teach "said controller.....another message". However, Lytle et al teach on Fig. 23 an email reply to an original email message. The email reply shown on Fig. 23 is the claimed "a message which is threaded within another message". When the original email sender opens this reply email the original mail sender is prompted with options as "Message", "Options", "Other", and "Customer" on Fig. 23.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2645

- Maurille (US: 6484196) teaches internet messaging system and method for use in computer networks..

9. Any inquiry concerning this communication or earlier communication from the examiner should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any inquiry of a general nature or relating to the status of this application or proceeding should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to TC2600's Customer Service FAX Number 703-872-9314.

Patent Examiner

Art Unit 2645

Ming Chow



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

